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GREENBERG-TRAURIG
1750 TYSONS BOULEVARD, 12TH FLOOR
MCLEAN, VA 22102

EXAMINER

BUI, KIM T

ART UNIT PAPER NUMBER

3626

DATE MAILED: 09/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/737,810

Applicant(s)

STRAUBE ET AL.

Examiner

Kim T. Bui

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2001.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 10-14, 18, 30-45 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(A) "said medical document files" in claim 10, on line 5, "said system computer" in claim 10, line 6 lacks clear antecedent basis;

(B) "medical document" in claim 18, line 5 is misspelled; "said patient review and acceptance" in claim 18, line 12 lacks clear antecedent basis;

(C) "said plurality of data" in claim 30, lines 1-2 lacks antecedent basis;

(D) Language in claim 31, lines 8-9, "analyzing..... medical procedure is unclear", is unclear for the claim recite a system comprising elements.

Dependent claims 11-14, 31-45 incorporate the deficiencies of the claim they depend on and therefore are rejected

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claims 1,6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessette (6263330) in view of Roberge et al. (6154750).

(A) As per claim 1, Bessette discloses a system for archiving and retrieving medical documents comprising:

a. electronic device (i.e. client computer) for accessing a database through a server. Bessette, col. 4, lines 20-22, col. 8, lines 56-59; Fig. 5;

b. a software application loaded on at least one of client or server for providing user interface. Bessette, col. 9, lines 1-16, col. 8, lines 7-10, col.11, lines 40-59;

c. an Internet browser loaded on at least one of the client or server for the transmission of at least one medical document file. Bessette, col. 6, lines 32-33; col. 8, lines 15-25, col. 12, lines 23-43; col. 15, lines 65-68;

d. wherein the server retrieves medical documents files from database and transmit the files to the electronic device for displaying on the user interface. Bessette, Fig.10, col. 4, lines 18-24.

Bessette fails to explicitly recite the user interface includes a tree view file navigation. This, however, is well known as evidenced by Roberge et al. Roberge et al discloses a medical navigation system wherein hierarchical (i.e. tree) viewed is created for clinical data. Roberge et al, col. 2, line 65 to col. 3, line 57, Fig. 18 a-c, 19 a-b. It would have been obvious to one having ordinary skill in the art at the time of the invention to include tree view navigation into Bessette with the motivation of enhancing the presentation of data to efficiently integrate, navigate and comment upon variety of information. Roberge et al, col. 2, lines 35-40, 56-64.

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(B) As per claim 6, Bessette discloses client computer in Fig. 10, col. 6, lines 15-35.

5. Claims 2,3 rejected under 35 U.S.C. 103(a) as being unpatentable over Bessette and Roberge et al. as applied to claim 1 above, and further in view of Lenz (5784539).

(A) As per claims 2,3, Bessette software applications are for a single computer and for local or wide are network of computers. Bessette and Roberge, however, fail to explicitly recite the software installed in CD. This, however, is well known as evidenced by Lenz. Lenz discloses a medical expert network communication system having CD installed software. See Lenz, col. 7, lines 40-47. It would have been obvious to one having ordinary skill in the art at the time of the invention to include CD installed software in Bessette 's system with the motivation of providing various applications to implement the system's architectures and design.

6. Claims 4,5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessette and Roberge et al. as applied to claim 1 above, and further in view of Metz et al. (5978855).

(A) As per claims 4,5, Bessette software application is for a single computer and for local or wide are network of computers. Bessette and Roberge, however, fail to explicitly recite the software is an Application Service Provider application. This, however, is well known as evidenced by Metz et al. Metz et al. discloses a medical network communication system including downloaded software from service provider. See Metz et al, col. 26, lines 38-42, col. 42, lines 17-34. It would have been obvious to one having ordinary skill in the art at the time of the invention to include downloaded software from

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service provider in Bessette 's system with the motivation of with the motivation of providing various applications to implement the system's architectures and design.

7. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessette and Roberge et al. as applied to claim 1 above, and further in view of Bro (5596994).

(A) As per claims 7-9, Bessette and Roberge fail to teach that the electronic device is PDA, phone or beeper. This, however, is well known as evidenced by Bro. Bro discloses a medical information communication system wherein the client terminal includes mobile personal computers, pocket computers such as PDA (Personal Digital Assistants), cellular phone, beeper, etc... . See Bro, col. 3, lines 5-12, col. 9, lines 55-65, col. 33, lines 40-65. It would have been obvious to one having ordinary skill in the art at the time of the invention to include PDA, cell phone, beeper with the motivation of providing various communication modes to increase the applicability of the system. See Bro, col. 3, lines 5-12.

8. Claims 10, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessette (62632330) in view of Boudrie et al. (5890165).

(A) As per claim 10, Bessette discloses a method for archiving and retrieving medical documents comprising the steps of:

a. establishing a client computer to a system computer communication link.

Bessette, col. 6, lines 15-33;

b. selecting a medical documents from user interface as part of the software application. Bessette, col. 11, line 40 to col. 12, line 42;

c. accessing medical documents from system computer. Bessette, Fig. 5, col. 4, lines 20-24; col. 8, lines 53-68;

d. transmitting said accessed medical document to said client computer. Bessette, col. Fig. 5, col. 4, lines 20-24; col. 5, lines 19-27; col. 9, lines 15-35, col. 20, 37-40;

e. displaying the medical document on the user interface. Bessette, col. 4, lines 20-24.

Regarding the step for determining which files stored on the client computer, which files stored on the system computer. Bessette teaches that the server manages the database, including sorting, modifying, updating, searching the files. Bessette, col. 17, lines 25-65, col. 9, lines 17-19. It is readily apparent that to carry out these functions, the files should be determined. Bessette does not expressly recite the files stored on the client computer are determined. However, the client has its own database, it is therefore logical that basis housekeeping function is performed. Furthermore, Boudrie et al teaches a system for automatic discovery of databases. The databases are interrogated to determine which files or tables are present. See Boudrie et al, the abstract, col. 2, lines 49-54, col. 7, lines 25-50. It would have been obvious to one having ordinary skill in the art at the time of the invention to include the steps for determining which files are present in to Bessette with the motivation of enhancing the backup and recovery of databases without comprising data integrity. Boudrie, col. 3, lines 3-5.

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(B) As per claim 12, Bessette discloses the communication link over network including the Internet. Bessette, col. 6, lines 29-34.

9. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bessette and Boudrie et al. as applied to claim 10 and further in view of Roberge et al. (6154750).

(A) As per claim 11, Bessette and Boudrie fail to expressly recite the tree view navigation. This, however is well known as evidenced by Roberge et al. Roberge et al discloses a medical navigation system wherein hierarchical (i.e. tree) viewed is created for clinical data. Roberge et al, col. 2, line 65 to col. 3, line 57, Fig. 18 a-c, 19 a-b. It would have been obvious to one having ordinary skill in the art at the time of the invention to include tree view navigation into Bessette with the motivation of enhancing the presentation of data to efficiently integrate, navigate and comment upon variety of information. Roberge et al, col. 2, lines 35-40, 56-64.

10. Claims 13, 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bessette and Boudrie et al. as applied to claim 10 and further in view of Rakshit et al (5999909).

(A) As per claim 13, Bessette and Boudrie fail to expressly recite the accessed medical documents includes medical consent. This, however is well known as evidenced by Rakshit et al. Rakshit et al. disclose a system for establishing consent for medical treatment. See Rakshit et al, the abstract, col. 6, line 41 to col. 7, line 45. It would have been obvious to one having ordinary skill in the art at the time of the

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invention to include medical consent in the documents disclosed Bessette with the motivation of conforming to standard practice. Rakshit et al, col. 1, lines 20-24.

(B) As per claim 14, Bessette and Boudrie fail to teach the step for printing the medical document in standard format. This, however, is well known as evidenced by Rakshit et al. Rashits teaches a system for establishing consent for medical treatment including the step for printing the medical consent. Rakshit et al. Fig.4. It would have been obvious to one having ordinary skill in the art at the time of the invention to include the step for printing medical document disclosed in Bessette with the motivation of keeping a record for future reference.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 15-17 are rejected under 35 U.S.C. 102(e) as being anticipated by Bessette (6263330)

(A) As per claim 15, Bessette discloses a system for archiving and retrieving medical image documents comprising:

a. electronic device (i.e. client computer) for accessing a database through a server. Bessette, col. 4, lines 20-22, col. 8, lines 56-59; Fig. 5;

b. a software application for providing user interface. Besette, col. 11, lines 40-43, 56-59;

c. an Internet for the transmission of at least one medical document file.
Besette, col. 6, lines 32-33;col. 12, lines 23-43;

d. wherein the server retrieves medical documents files from database and transmit the files to the electronic device for displaying on the user interface. Besette, Fig.10, col. 4, lines 18-24.

(B) As per claim 16, Besette discloses software application is loaded on at least one of system server or the electronic device. Besette, col. 8, lines 8-10, col. 6, lines 23-25, Fig. 5.

(C) As per claim 17, Besette discloses Internet browser on col. 15, lines 65-68.

13. Claims 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Besette ((6263330) in view of Rakshit et al (5999909).

(A) As per claim 18, Besette discloses a method for archiving and retrieving medical documents comprising the steps of:

a. establishing a client computer to a system computer communication link.
Besette, col. 6, lines 15-33;

b. selecting a medical documents from user interface as part of the software application. Besette, col. 11, line 40 to col. 12, line 42;

c. accessing medical documents from system computer. Besette, Fig. 5, col. 4, lines 20-24;col. 8, lines 53-68;

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d. transmitting said accessed medical document to said client computer.

Bessette, col. Fig. 5, col. 4, lines 20-24; col. 5, lines 19-27; col. 9, lines 15-35, col. 20, 37-40;

e. displaying the medical document on the user interface. Bessette, col. 4, lines 20-24.

Bessette fails to teach the medical consent and the acceptance of the medical treatment. This, however is well known as evidenced by Rakshit et al. Rakshit et al. disclose a system for establishing certified consent for medical treatment using a training system for monitoring patient's knowledge and acceptance. See Rakshit et al, the abstract, col. 6, line 41 to col. 7, line 45, col. 5, lines 34-55. It would have been obvious to one having ordinary skill in the art at the time of the invention to include medical consent in the system of Bessette with the motivation of conforming to standard practice. Rakshit et al, col. 1, lines 20-24.

14. Claims 19,21-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Iliff (6071236)

(A) As per claim 19, Iliff discloses a method for tracking, diagnosing and treating patient's complications comprising:

- a. providing questionnaire(s) for a medical procedure in an electronic communication medium to at least one patient and doctor. Iliff, col. 4, lines 24-43.
- b. receiving questionnaire(s) response data from at least one questionnaire. Iliff, col. 4, lines 24-43.

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c. analyzing the response data for trends associated with the medical procedure.

Iliff, col. 4, line 44 to col. 5, line 21, col. 6, lines 44-49, col. 43, lines 15-25, col. 53, lines 47 to col. 54, line 50.

(B) As per claim 21-22, Iliff teaches the storing, retrieving and analyzing of data over a period of time for long term or short term data trends. Iliff, col. 43, line 15 to col. 47, page 30.

(C) As per claims 24-29, Iliff teaches the receiving and analyzing of patient medical record, and physician data (reads on event data, patient and physician data), procedure, diagnosis and treatment data (reads on procedure and treatment data), and x-ray, CAT scan, MRI scan (reads on exam data) on col. 12, line 26-60, col. 14, lines 13-17, col. 17, lines 44-51, col. 21, line 10 to col. 23, line 15, col. 24, lines 34 to col. 25, line 15, col. 6, line 63 to col. 7, line 4.

(D) As per claims 23, 30, Iliff teaches different modes of operation, including real time operation mode wherein data is mined in real time for quickly identifying predictive medical treatment. Iliff, col. 10, lines 19-20, col. 25, lines 30-63, col. 9, lines 55-60.

15. Claims 20, 31-45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Iliff (6071236) in view of Bessette (6263330).

(A) As per claim 20, Iliff teaches the telephone communication network and fails to explicitly recite the Internet. However, it is well known in the medical art to include Internet communication as evidenced by Bessette. See Bessette, col. 6, lines 15-34. It would have been obvious to one having ordinary skill in the art at the time of the

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invention to include the Internet communication with the motivation of expanding the application to world wide domain.

(B) As per claim 31, Iliff discloses a system for tracking, diagnosing and treating patient's complications comprising:

a. a system for providing questionnaire(s) for a medical procedure. Iliff, col. 4, lines 24-43, col. 11, line 56 to col. 13, line 36, col. 25, lines 35-46, col. 35, lines 20-36, col. 36, lines 35-3.

b. an electronic device for user to access the system to interact with the questionnaire(s). Iliff, col. 7, line 5 to col. 8, line 10.

c. providing questionnaire response data. Iliff, col. 4, lines 24-43, col. 4, lines 43-45, lines 51-53, col. 11, lines 20-25.

d. database for storing information including questionnaire response data. Iliff, col. 8, lines 9-10, col. 14, lines 20-25, col. 21, lines 11-16.

e. analyzing the response data for trends associated with the medical procedure. Iliff, col. 4, line 44 to col. 5, line 21, col. 6, lines 44-49, col. 43, lines 15-25, col. 53, lines 47 to col. 54, line 50.

Iliff fails to explicitly recite a server. However, the use of client server network communication is well known in the medical art as evidenced by Bessette. Bessette discloses the Internet medical distribution network including a network server. Bessette, col. 5, lines 1-2, col. 6, lines 15-33. It would have been obvious to one having ordinary skill in the art at the time of the invention to include a network server with the motivation of enhancing system administration.

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(C) As per claims 32-33, Iliff teaches that user can be patient or physician. Iliff, col. 63, lines 25-65, col. 11, lines 25-32.

(D) As per claim 34, graphic user interface is disclosed in Iliff, col. 4, lines 24-32, and Bessette, col. 11, lines 40-65.

(E) As per claims 35, the claim repeats the limitation of claim 20 and is rejected for the same reasons set forth in the rejection of claim 20.

(F) As per claims 36-41, the claims repeat the limitations of claims 24-29, and therefore are rejected for the same reasons set forth in the rejections of claims 24-29.

(G) As per claims 42,43, the claims repeat the limitations of claims 21,22, and therefore are rejected for the same reasons set forth in the rejections of claims 21, 22.

(H) As per claims 44-45, the claims repeat the limitations of claims 23,30, and therefore are rejected for the same reasons set forth in the rejection of claims 23,30.

Claim Rejections - 35 USC § 101

16. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

17. Claims 19-30 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two-prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete, and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural

phenomena) that do not apply, involve, use, or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) and therefore are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. The body of the claim(s) must recite how the technological art is employed to produce a useful, concrete and tangible result in a non-trivial manner.

(A) In the present case, claims 19-30 recite an abstract idea only. The recited steps of the claims are merely for providing questionnaire, receiving response, and analyzing the response, and do not apply, involve, use, or advance the technological arts since all of the recited steps can be performed in the mind of the user or by use of a pencil and paper. The communication medium and the Internet in claims 19, 20 are trivial and do not describe how the technological art is employed to produce a useful, concrete and tangible result in a non-trivial manner.

In addition, for a claimed invention to be statutory, it must produce a useful, concrete, and tangible result. In the present case, the claimed invention produces a method for analyzing responses (i.e., repeatable) used in medical procedures (i.e., useful and tangible).

Although the recited process produces a useful, concrete, and tangible result, since the claimed invention, as a whole, is not within the technological arts as explained above, claims 19-30 deemed to be directed to non-statutory subject matter.

Conclusion

18. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. "Computer-based medical image distribution system" (6260021); "Computer system for accessing medical information" (5915240); "Medical imaging system with interface" (6353445); "Method for controlling access to personal information" (6073106); "A Web-Enabled Framework For Smart Card Application in Healthcare" Chan Alvin et al., Sept. 2001, Communications of the ACM, 44,9,76, Dialog file 149, Acc no. 02021813.

19. Inquiry concerning this communication or earlier communications from the examiner should be directed to Kim T. Bui whose telephone number is 703-305-5874. The examiner can normally be reached on Monday-Friday from 8:30A.M. to 5:00P.M..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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KTB



**ALEXANDER KALINOWSKI
PRIMARY EXAMINER**